REMARKS/ARGUMENTS

Rejection of Claims Under 35 U.S.C. §112, Second Paragraph

The Examiner rejects Claims 31-33 under §112, second paragraph, allegedly because the term "metabolic precursor" and "precursor" used in the claims is unclear. Applicants have amended the claims in a fashion believed to overcome the Examiner's §112 concerns and as such, respectfully request favorable consideration thereof.

Claim Objections

The Examiner objects to Claims 31 and 33 due to the misspelling of turmeric. Appropriate correction to the claims has been made.

Double Patenting

Applicants hereby submit a Terminal Disclaimer to address the Examiner's obviousness double patenting concerns with respect to U.S. Patent Nos. 6,344,220 and 5,916,565. Applicants believe that such rejections should be removed and that Claims 25-30 should be therefore passed to allowance.

Rejection of Claims 31 and 33 under 35 U.S.C. §103

The Examiner contends that Claims 31 and 33 are rendered obvious in view of a combination of Hirschhorn, Hobbs, Castleman, U.S. Patent No. 5,364,845 and U.S. Patent No. 3,887,703. Applicants respectfully contend that the Examiner's apparent need to combine the teachings of five

separate references in order to fashion an obviousness rejection of the above-referenced claims is itself evidence of the non-obviousness of the claimed invention. Although the Examiner contends that each of the references teaches the use of one or more of the claimed components of the overall claimed composition to treat arthritis, there is simply no teaching or suggestion in any of such references to make the combination made by Applicants other than the guidance provided by the Applicants' disclosure. It is impermissible within the framework of §103 to pick and choose from multiple references only so much as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *See Polaroid Corporation v. Eastman Kodak Company*, 229 USPQ 561 (Fed. Cir.), cert. denied, 471 U.S. 850 (1996). It is entirely appropriate that combination claims can consist of combinations of old elements. *Clearstream Wastewater Systems v. Hydroaction, Inc.*, 206 F.3d 1440, 1446, 54 USPQ 2d 1185, 1189-1190 (Fed. Cir. 2000). "The notion that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, Section 103." *Panduit Corporation v. Dennison Manufacturing Co.*, 810 F.2d 1561, 1575, 1 USPQ 2d 1593, 1603 (Fed. Cir. 1987). The showing of combinability must be "clear and particular." *In re Dembiczak*, 175 F.3d at 999, 50 USPQ 2d at 1617. The genius of invention is often a combination of known elements which in hindsight seems preordained. When the art in question is relatively simple, the opportunity to judge by hindsight is particularly tempting. Consequently, tests of whether to combine references need to be applied rigorously. *McGinley v. Franklin Sports, Inc.*, 60 USPQ 2d 1001 (Fed. Cir. 2001). The relevant portions of a reference include not only those teachings which

would suggest particular aspects of an invention to one of ordinary skill in the art, but also those teachings which would lead such a person away from the claimed invention. *In re Mercier*, 185 USPQ 774, 778 (CCPA 1975).

Based upon the above-referenced well established law, it is not at all clear that the combination made by the Examiner would have been made by one of ordinary skill in the art, and is even less clear whether the requisite motivation exists to make such combination. That individual arthritic treatments utilizing various different components is sufficient to provide such motivation is not at all "clear and particular". A motivation suggestion to combine references must be explicit. *Winner Int'l Royalty Corp. v. Wang*, 48 USPQ 2d 1139 (D.C.D.C 1998). Such a motivation does not appear to exist in any of the references relied upon by the Examiner to reject the present claims.

Indeed, the Examiner admits that the particular amount of components claimed by the Applicants are not disclosed or suggested in any of the references. The Examiner attempts to remedy this deficiency by merely concluding that one of ordinary skill in the art would routinely optimize particular parameters. What the Examiner fails to note, however, is that the prior art would need to suggest how such optimization of particular ingredients would be employed. Given the relative narrowness of the claimed compositions and the distinctive quantitative amounts of each particular component, Applicants respectfully submit that no such disclosure, teaching or suggestion is provided in the prior art and that one of ordinary skill in the art would not have arrived at the particular quantitative limitations of the particular combination of components as set forth in the claims. Applicants respectfully request that the Examiner reconsider and withdraw all such rejection of claims.

Rejection of Claim 32 Under 35 U.S.C. §103

The Examiner rejects Claim 32 as alleged being rendered obvious in view of Hobbs, Castleman, the '845 patent and the '703 patent. For the reasons as set forth above, Applicants respectfully request that the Examiner reconsider and withdraw such rejection of claim 32.

Attached hereto is a marked up version of the changes made to the specification and claims by the current amendment. The attached page is captioned **"Version With Markings to Show Changes Made**."

Applicants' counsel requests the courtesy of a telephone interview in the event the Examiner still believes that any of the presented claims are not patentable. Applicants' counsel can be reached directly at (303) 863-2977.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Claims 31-33 have been amended as follows:

31. (Once Amended) A composition for the treatment of arthritis, stiffness, joint mobility and joint pain in vertebrates, comprising:

(a) an herbal phytochemical component consisting essentially of a combination of Devil's Claw, alfalfa, yucca, ginger and turmeric[tumeric]; and

(b) a component [metabolic precursor] selected from the group consisting of glucosamine, glucosamine salts, chondroitin sulfate, mucopolysaccharides and tissue preparations containing chondroitin sulfate, wherein the daily dose of such composition comprises from about 50 to about 2000 mg of said component [metabolic precursor] per 25 pounds of body weight, and from about 2 to about 3000 mg of said phytochemical per 25 pounds of body weight.

32. (Once Amended) A composition for the treatment of arthritis, joint stiffness, joint mobility and joint pain in vertebrates, consisting essentially of:

(a) an herbal phytochemical component consisting essentially of a mixture of ginger, turmeric, yucca and alfalfa; and

(b) a component [metabolic precursor] selected from the group consisting of glucosamine, glucosamine salts, chondroitin sulfate, mucopolysaccharides and tissue preparations containing chondroitin sulfate, wherein the daily dose of such composition comprises from about 50 to about 2000 mg of said component [metabolic precursor] per 25 pounds of body weight, and from about 2 to about 3000 mg of said phytochemical per 25 pounds of body weight.

33. (Once Amended) A composition for the treatment of arthritis, joint stiffness, joint mobility and joint pain in vertebrates, based on 25 pounds of body weight, consisting essentially of from about 50 to 220 mg of ginger, from about 50 to 400 mg of turmeric [tumeric], from about 400 to 3000 mg of yucca, from about 200 to 2000 mg of Devil's Claw, from about 100 to 800 mg of alfalfa, and from about 50 to 2000 mg of a component [precursor] selected from the group consisting of glucosamine, glucosamine salts, chondroitin sulfate, mucopolysaccharides and tissue preparations containing chrondroitin sulfate.